

REMARKS

Claims 4-6, 13-16, and 23-35 are pending in the application; the status of the claims is as follows:

Claims 31-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,383,754 to Sumida et al. ("Sumida") in view of U.S. Patent No. 4,739,369 to Yoshiura et al. ("Yoshiura").

Claims 4-6, 13-16, and 23-30 are allowed.

35 U.S.C. § 103(a) Rejection

The rejection of claims 31-35 under 35 U.S.C. § 103(a), as being unpatentable over Sumida in view of Yoshiura, is respectfully traversed based on the following.

Claim 31 includes the limitations of "means for editing pixel density data" and means for controlling "which permits said means for editing to edit an image when all images corresponding to said plurality of originals are uniform in size and otherwise prohibiting said means for editing from editing an image." Thus, the means for controlling either permits or prohibits operation of the means for editing depending upon the size of the plurality of originals.

The Office Action indicates the following portions of Sumida disclose certain limitations of claim 31: column 19, lines 38 – 49 (means for editing), and column 39, line 43 – column 40, line 62, column 47, line 53 – column 50, line 15, and column 74, lines 14 – 64 (means for controlling). Column 19, lines 38 – 49 disclose a means for editing comprising a compressor (COMP) 290 and an expander (EXP) 291 such that data may be stored in a compressed state to conserve memory space and expanded upon readout. Column 39, line 43 – column 40, line 62 is silent with respect to any type of controller that permits or prohibits operation of the compressor and expander indicated as

the means for editing in column 19, lines 38 – 49. Similarly, column 47, line 53 – column 50, line 15 is silent with respect to any type of controller that permits/prohibits operation of the indicated means for editing (compressor and expander). Lastly, column 74, lines 14 – 64 are likewise silent with respect to a controller that permits/prohibits operation of the compressor and expander, i.e., the means for editing. The Office Action also indicates that column 30, line 33 – column 31, line 26 of Sumida disclose a controller that prohibits operation of the means for editing. A review of this section shows it fails to disclose a controller that permits/prohibits operation of the compressor and expander. Therefore, the indicated portions of Sumida fail to disclose or suggest an editing means and a controller for permitting/prohibiting operation of this editing means as required by claim 31 and therefore Sumida cannot anticipate or render obvious the invention of claim 31.

The Office Action combines Sumida with Yoshiura. In particular, the Office Action indicates means for editing data is disclosed in column 9, lines 26 – 65 and in column 11, lines 24 – 61 of Yoshiura. Column 9, lines 26 – 65, while disclosing a number of elements, does not disclose that any of these elements are means for editing data, but rather are more directed to the flow or storage of data within Yoshiura's apparatus. Similarly, column 11, lines 24 – 61 are silent with respect to any means for editing data. Because the portions of Yoshiura indicated by the Office Action do not disclose or suggest any means for editing, it cannot disclose a controller for permitting/prohibiting operation of a means for editing. Therefore, Sumida and Yoshiura, either singularly or in combination, do not disclose or suggest means for editing and a controller for permitting/prohibiting operation of the means for editing. As both the means for editing and the controller for permitting/prohibiting operation of the means for editing are limitations of claim 31, the combination of Sumida and Yoshiura fails to render obvious the invention of claim 31.

Claim 32 depends from claim 31. As the combination of Sumida and Yoshiura fails to disclose each limitation of claim 31, the combination of Sumida and Yoshiura cannot render obvious the invention of claim 32 that depends therefrom.

Claim 33 includes the limitation of means for controlling a stapler such that the operation of the stapler is permitted when the sizes of the images corresponding to the originals are uniform and prohibiting its operation otherwise, i.e., when the sizes of the images corresponding to the originals are not uniform.

The Office Action indicates Sumida discloses a controller for permitting operation of a stapler in column 39, line 43 – column 40, line 62, column 47, line 53 – column 50, line 15, and column 74, lines 14 – 64. Turning first to column 39, line 43 – column 40, column 40, lines 31 – 33 explicitly state “[w]hen the image orientation does not match the reference staple position data, defective stapling is prevented...” (Emphasis added.) Thus, operation of the stapler is permitted/prohibited based upon the orientation of the images, not their size. The section from column 47, line 53 to column 50, line 15, discloses the handling of documents having text with different orientations, e.g., vertically long horizontally written and horizontally long horizontally written. Therefore, the document handling is based upon the orientation of the text within a document, not the size of the images. Lastly, column 74, lines 14 – 64 again addresses the issue of orientation by stating at lines 20 – 21, “[w]hen a document of different orientation is detected, recovery is effected...” (Emphasis added.) Thus, control of Sumida’s stapler is again disclosed as being based upon image orientation, not the sizes of the images. Since the portions of Sumida indicated by the Office Action do not disclose or suggest permitting or prohibiting operation of a stapler based upon the sizes of the image of the originals, Sumida cannot anticipate or render obvious the invention of claim 33. While the Office Action combines Sumida with Yoshiura, it does not indicate that Yoshiura discloses means for controlling that permits/prohibits operation of a stapler. Thus, the combination of Sumida and Yoshiura fails to disclose or suggest means for controlling a stapler that permits/prohibits operation thereof based upon the sizes of the image originals.

Because the combination of Sumida and Yoshiura fails to disclose or suggest each limitation of claim 33, the combination of Sumida and Yoshiura cannot render obvious the invention of claim 33.

Claim 34 includes the limitations of means for editing pixel density data and means for controlling. The means for editing permits editing of pixel density data in a manner suitable to provide two images on a single side of a sheet. The means for controlling permits or prohibits operation of the means for editing depending upon whether image sizes of pixel density data are uniform or not.

The Office Action indicates column 24, line 50 – column 27, line 8 of Sumida discloses means for editing pixel density data of an image. While this may or may not be true, this portion of Sumida does not disclose means for editing pixel density data in a manner suitable to provide two images on a single side of a sheet. In particular, this portion of Sumida discloses shifting, enlarging, or reducing pixel density data for one image, but does not disclose combining pixel density data from two images in the claimed manner. The Office Action indicates three additional portions of Sumida disclose means for controlling the means for editing based upon whether or not the pixel density data are uniform in size. As discussed above, these three portions of Sumida disclose permitting/prohibiting operation based upon the orientation of the image, or the orientation of the text, not the uniformity of the sizes of the pixel density data. Thus, Sumida fails to disclose or suggest at least two limitations of claim 34, and cannot anticipate or render obvious the invention of claim 34.

The Office Action also combines Sumida with Yoshiura for claim 34. In particular, the Office Action indicates means for editing data is disclosed in column 2, lines 17 – 60, column 9, lines 26 – 65, and in column 11, lines 24 – 61 of Yoshiura. Column 2, lines 17 – 60, while disclosing a number of objects of the invention, does not disclose editing of pixel density data in a manner suitable to provide two images on a single side of a sheet. Column 9, lines 26 – 65, while disclosing a number of elements,

does not disclose that any of these elements are means for editing data in a manner suitable to provide two images on a single side of a sheet. Similarly, column 11, lines 24 – 61 are silent with respect to any means for editing data in a manner suitable to provide two images on a single side of a sheet. Because the portions of Yoshiura indicated by the Office Action do not disclose or suggest any means for editing data in a manner suitable to provide two images on a single side of a sheet, it cannot disclose a controller for permitting/prohibiting operation of such a means for editing. Therefore, Sumida and Yoshiura, either singularly or in combination, do not disclose or suggest means for editing data in a manner suitable to provide two images on a single side of a sheet and a controller for permitting/prohibiting operation of the means for editing. As both the means for editing data in a manner suitable to provide two images on a single side of a sheet and the controller for permitting/prohibiting operation of the means for editing are limitations of claim 34, the combination of Sumida and Yoshiura fails to render obvious the invention of claim 34.

The Office Action, with respect to claim 35, asserts that Sumida discloses a controller for permitting/prohibiting operation of a stapler based on the uniformity of the size of the pixel density data. As described above regarding claim 33, Sumida permits/prohibits operation of a stapler based upon the orientation of the image or the orientation of the text, not the uniformity of the size of the pixel density data. Thus, Sumida fails to disclose or suggest at least one limitation of claim 35, and cannot anticipate or render obvious the invention of claim 35. The Office Action, on page 10, asserts that column 11, lines 39 – 61 of Yoshiura disclose a controller that permits the means for editing to operate when the image data is uniform in size. As claim 35 pertains to permitting/prohibiting operation of a stapler, any disclosure at column 11, lines 39 – 61 of Yoshiura is irrelevant. Therefore, Sumida and Yoshiura, either singularly or in combination, do not disclose or suggest a controller for permitting/prohibiting operation of a stapler based upon the uniformity of size of stored pixel density data. As such a controller for permitting/prohibiting operation of a stapler is a limitation of claim 35, the combination of Sumida and Yoshiura fails to render obvious the invention of claim 35.

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Reply to Office Action of January 26, 2005

Accordingly, it is respectfully requested that the rejection of claims 31-35 under 35 U.S.C. § 103(a) as being unpatentable over Sumida in view of Yoshiura, be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are respectfully requested.

This Response does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims beyond the number of claims originally paid for. Accordingly, no fee based on the number or type of claims is currently due. If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such a Petition for Extension of Time or any other fee required by this response, including any fee pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin

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Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

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